

USSN: 10/017,157
Amendment dated November 12, 2004
Reply to Office Action of July 14, 2004

REMARKS/ARGUMENTS

Status of the Claims

Claims 1 and 3-15 were pending. By this Amendment, Claims 1, 9, and 11 have been amended and new claims 16-18 have been added. No new matter has been added. Accordingly, claims 1 and 3-18 are pending.

Claim Rejections under 35 U.S.C. §103(a) (Anderle in view of Stein, Kim and Handbook of Cosmetic Science)

The Examiner rejected claims 1, 3-4, 6-7, and 11 as being obvious over Anderle in view of Stein, Kim and Handbook of Cosmetic Science.

In response, Applicants respectfully disagree that the cited references teach or suggest every limitation in the claims. Accordingly, the references together with knowledge in the art do not render the claims obvious.

Briefly, Applicants respectfully suggest that the motivation to combine the references do not make out a prima facie case of obviousness. This is because the combined teachings provide, at most, an obvious to try motivation. The references do

USSN: 10/017,157
Amendment dated November 12, 2004
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not suggest that the claimed method would be reasonably expected to succeed for the following reasons listed below.

Anderle discloses methods of preparing water dispersible and/or soluble polyurethanes ("wsPUs"). In addition, Anderle discloses a sunscreen lotion. Kim discloses wsPUs and the particular diols previously recited in claim 1. Stein mentions oil-in-water sunscreens as preferred sunscreen formulations. The Handbook of Cosmetic Science and Technology mentions forming emulsions using a variety of combinations of ingredients which are not specifically specified. The claimed invention is directed toward a method of protecting the skin from exposure to light by applying an o/w formulation such as in a form of an emulsion comprising a water dispersible polyurethane composition and at least one UV filter substance.

As the Examiner would acknowledge, these references alone do not disclose all the elements of the claimed invention. Taken together, these references would also not render the claimed invention obvious because they would not motivate persons in the art to combine all the references together. For example, it is not mentioned in Stein that combining a sunscreen with polyurethanes would be useful. A sunscreen could be combined with many different compounds resulting in different types of formulations. The same analogy applies to Kim. Kim discloses polyurethanes but does not mention nor suggest anything else relevant to the claimed invention. Polyurethanes can be combined with many different elements to create a formulation. The same analogy applies to Anderle. Anderle simply discloses polyurethane dispersions and mentions a sunscreen. In response to the Handbook of Cosmetic Science and Technology, Applicants note that although it discloses emulsions formed by a combination of ingredients, it does not specifically disclose nor suggest forming an emulsion by

USSN: 10/017,157

Amendment dated November 12, 2004

Reply to Office Action of July 14, 2004

combining polyurethanes with at least one UV filtering substance. Although the Handbook generally states that many combinations of ingredients can be formed, this statement is so general that it suggests that anything can be formed when combined.

Thus, taking all the references together, it would not have been obvious to one of ordinary skill in the art to combine all the references together. One of ordinary skill in the art would not have read Stein or any of the other references cited and specifically come to the conclusion that o/w formulations such as emulsions could be formed by combining polyurethanes with sunscreen. The Examiner has given no specific explanation as to how and why one of ordinary skill in the art would come to this conclusion based on all the references. For example, although the Examiner states that all these references relate in the same art (i.e. personal care application), there are probably hundreds or thousands of different compounds which can be formed into a formulation for personal care application use.

Thus, it is respectfully suggested that Examiner's proposed modification of Anderle's composition with Kim's wsPUs and Stein's sunscreens and the Handbook's generalized statements regarding emulsions would rise to only an obvious to try level of motivation, which is known to not be sufficient for a prima facie case of obviousness.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

USSN: 10/017,157
Amendment dated November 12, 2004
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Claim Rejections under 35 U.S.C. §103(a) (Anderle in view of Stein, Kim, Handbook of Cosmetic Science, and Koch et al.)

The Examiner rejected claims 8-10 and 12-15 as being obvious in view of Anderle in view of Stein, Kim, Handbook of Cosmetic Science, and Koch et al.

In view of the applicants' arguments mentioned above, Applicants respectfully disagree that the cited references teach or suggest every limitation in the claims. Accordingly, the references together with knowledge in the art do not render the claims obvious.

In view of these comments, it is respectfully requested that the rejection under § 103(a) be withdrawn.

Claim Rejections under 35 U.S.C. §103(a) (Anderle in view of Stein, Kim, Handbook of Cosmetic Science, and Gers-Barlag et al.)

The Examiner rejected claim 5 as being obvious over Anderle in view of Stein, Kim, Handbook of Cosmetic Science, and Gers-Barlag et al.

In view of the applicants' arguments mentioned above, Applicants respectfully disagree that the cited references teach or suggest every limitation in the claims. Accordingly, the references together with knowledge in the art do not render the claims obvious.

USSN: 10/017,157
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In view of these comments, it is respectfully requested that the rejection under
§ 103(a) be withdrawn.

CONCLUSION

An early and favorable action is earnestly solicited.

Respectfully Submitted,

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